

REMARKS

Amendments to the Claims:

Claims 10-11 are new. Claims 1, 3, and 8 are amended. Claims 2 and 7 are cancelled. No new matter has been added.

Claim Rejections:

Rejections Based on 35 U.S.C. § 103(a)

The Examiner rejected all pending claims as obvious over Kaplan (US 6,514,193) in view of Mentor and Coniglione (US 5,713,828). Applicant respectfully disagrees.

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the reference(s) must teach or suggest all the claim limitations. MPEP § 706.02(j).

None of the cited references, alone or in combination, teach or suggest every element of the amended claims. The method of claim 1, as amended, teaches threading treatment seeds onto a material and heating the material to cause the material to expand and thus to fix the treatment seeds into position, *i.e.*, according to the number and spacing of a treatment strand. None of the cited references teach the threading step followed by the positioning and heating steps. The Examiner notes, “Kaplan [] does not teach a step of creating a treatment strand by threading a material through a bore through the treatment seeds.” Office Action at 3. Mentor makes no reference to a threading step. Coniglione discloses threading the seeds; however, that reference makes no mention of fixing the treatment seeds into prescription position with heating to expand the material threaded through the seeds. Kaplan only teaches “melting” spacers to connect the spacers to seeds, Col. 15, ll. 1-3, and does not teach heating to expand a material to fill a bore through which a material is threaded. Because the three cited references fail to teach each element of claim 1, claim 1 is non-obvious over the cited art, and is allowable.

Because claims 3, 5, and 6 depend from claim 1, these claims also are allowable over the cited art. Applicant therefore respectfully requests reconsideration of the rejection and a Notice of Allowance.

Claim 2 has been cancelled because the subject matter now is taught in claim 8.

Claim 8 as amended is not obvious over the cited art because none of the cited references, alone or in combination, teach or suggest every element of claim 8. Coniglione and Mentor do not disclose crimping, and Kaplan does not teach crimping of a material that has been threaded through treatment seeds to keep seeds in place along the threaded material, as in the present invention. Rather, Kaplan is limited to use of spacers, and only teaches crimping a spacer that is attached to *the end* of a hollow seed by “direct attachment.” “For rod or cylinder-shaped seeds 10, to facilitate implantation, it is generally preferred that spacer 52 be attached *to the ends* of the seeds 10 . . .” *Id.* at Col. 15, ll. 4-6 (emphasis in italics supplied; emphasis of numerical element designations in original). In contrast, Claim 8 as amended of the present invention teaches, “crimping the threaded material near the ends of the treatment seeds, wherein said crimping step shapes the material to prevent displacement of the treatment seeds along the treatment strand.” Thus, in the present invention, spacers are not used, and the material is threaded through a bore, rather than connected the “direct attachment” and attached to the ends of the treatment seeds. Since neither Kaplan nor the other cited art disclose the crimping step of material threaded through a bore, Applicant respectfully submits that the obviousness rejection of claim 8 cannot stand, and requests reconsideration.

Claim 9 depends from claim 8 and therefore claim 9 is allowable over the cited art. Applicant respectfully requests reconsideration of the rejection of claims 8 and 9 and a Notice of Allowance.

Claim 7 has been cancelled and the rejection therefore is moot.

New claim 10 claims a prescription method of treating a tissue comprising the steps of:

- accepting a tissue treatment plan for the tissue to be treated, said treatment plan specifying a number and a spacing pattern of a plurality of treatment seeds to be provided on a treatment strand, each of said treatment seeds having a bore therethrough;

- placing the plurality of treatment seeds in a mold according to the number and the spacing pattern specified by the tissue treatment plan;

flowing a material into the mold so that the material fills the bores of the plurality of treatment seeds and the spacing around the plurality of treatment seeds; and

allowing the material to cool to fix the treatment seeds into position.

Claim 11 depends from claim 10 and adds allowing the material to expand.

None of the references, alone or in combination, teaches the placing, flowing, and allowing steps above, which are among the steps of the claimed method, whereby a material is flowed in and around a plurality of treatment seeds spaced according to a prescription plan, and the seeds thus are fixed into the prescription spacing.


In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if she can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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By: _____



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